

## **REMARKS**

Claims 1-4, 6-7, 9-10, 12-13, and 16 are pending and under examination. Applicants thank the Examiner for the allowance of claims 6 and 7, and for noting that claim 4 has been deemed allowable. Claims 1, 6, 9, 10, 12, and 16 have been amended herein. Applicants have amended the claims as the Examiner has suggested to advance the prosecution. Applicants expressly reserve the right to pursue any disclosed subject matter not now claimed in one or more continuing applications. The specification has also been amended. In particular, the title was amended at the Examiner's request.

### **Preliminary Matters**

Applicants thank the Examiner for his thorough search of the prior art through the filing date of the instant application. Applicants respectfully disagree, however, with the comments contained in paragraph 3 of the Office Action, which are not germane to the grounds of rejections set forth in the action. Since there is no rejection based on intervening art, Applicants have no burden of rebutting these comments at the present time, and do not concede the issue. Applicants will respond on the merits if and when it becomes necessary to do so.

The Office Action alleged that the title was not descriptive. In an effort to advance prosecution, Applicants have amended the title to that suggested by the Examiner. The objection is thus moot.

Claims 1, 6, 9, and 16 stand objected to because of the following alleged informalities: the claims recite "a mammalian histamine H4 receptor." In order to advance the prosecution of this application, the claims have been amended to remove the recitation "mammalian histamine H4 receptor where required. The claims where appropriate now recite "murine histamine H4 receptor", thus the grounds of the rejection are obviated. Applicants respectfully assert that the claim amendment is not narrowing because the claims continue to encompass those specific histamine H4 sequences relating to SEQ ID NO:8 and SEQ ID NO:5.

Claim 1 also stands objected to for the recitation “a polynucleotide encoding.” To advance prosecution, the language has been amended to that suggested by the Examiner, namely “a polynucleotide sequence encoding.” This amendment is not narrowing; the skilled artisan would readily understand the claim scope to be unchanged by this amendment.

### **The Claims are Fully Enabled**

Claims 1-3 and 12 stand rejected as allegedly failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. In giving weight to the preamble, the Office Action alleges that the claim 1 requires that the nucleic acids encode histamine H4 receptors. The Office Action further alleges that the nucleic acid of part (b) of claim is complementary to a nucleic acid which encodes a histamine H4 receptor, and thus will not encode a histamine H4 receptor. Applicants disagree with the rejection for lack of enablement, however, in order to advance the prosecution, Applicants have amended the preamble of the claim to clarify that what is claimed is “an isolated and purified nucleic acid molecule that encodes a murine histamine H4 receptor protein, or a complement of said nucleic acid molecule. . .” The scope of this claim as amended is not narrowed, and is fully enabled by the specification. Accordingly, the grounds of the rejection under 35 U.S.C. § 112, first paragraph are obviated. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3, and 12.

Claims 9, 10, and 16 stand rejected under 35 U.S.C. § 112, first paragraph because the specification allegedly does not reasonably provide enablement for cells residing in any host organism including humans. Although Applicants assert that the full scope of the claimed invention is enabled and the skilled artisan would readily be able to practice what is claimed, to advance the prosecution, Applicants have amended the claim to clarify that the claimed cells are “isolated,” as the Examiner has suggested. The entire scope of the invention as

claimed is thus clearly enabled. Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph for lack of enablement.

**The Claims are Sufficiently Definite Under 35 U.S.C. § 112, second paragraph**

Claims 12 and 13 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite because the term “substantially purified” is defined in the specification. The Examiner recommended amendment to “isolated.” While not concurring in the rejection, to advance the prosecution of the claims, Applicants have amended in accordance with the Examiner’s suggestion. The grounds of the rejections are thus eliminated. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is thus respectfully solicited.

**The Claims are Novel Over the Cited Stratagene Primers**

Claims 1-3 and 12 stand rejected under 35 U.S.C. § 102(a) as allegedly anticipated by the random primers on p. 66 of the 1991 Stratagene catalog. The Office Action proposes that Applicants may overcome the alleged anticipation of the claim by these random 9-mers by amending the claim to reflect that the polynucleotide sequence claimed in claim 1(b) is the full-length complement of that claimed in claim 1(a). Applicants have amended the claim to recite a polynucleotide sequence which is a full-length complement of a polynucleotide sequence encoding amino acids 1 to 391 of SEQ ID NO:8. These sequences clearly are not anticipated by the Stratagene random primers. Accordingly, the rejection under 35 U.S.C. § 102(a) is now moot. Applicants respectfully request reconsideration and withdrawal of the rejection to claim 1.

**DOCKET NO.:** JJPR-0032 (ORT-1377 DIV1)  
**Application No.:** 10/626,445  
**Office Action Dated:** April 26, 2005

**PATENT**

**Conclusion:**

The amendments and remarks herein are fully responsive to the outstanding Office Action. The claims are now in condition for allowance, and an early and favorable Notice to that end is earnestly solicited. To resolve any issues prior to allowance, the Examiner is invited to conference with Applicants' undersigned representative telephonically at 215-557-5986 during normal business hours, or by arrangement.

Respectfully submitted,

Date: September 26, 2005

Scott E. Scioli

Scott E. Scioli  
Registration No. 47,930

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439